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10/665,140	09/22/2003	Naoki Mochizuki	Q77096	5800

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EXAMINER

ADAMS, CHARLES D

ART UNIT PAPER NUMBER

2164

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/665,140	Applicant(s) MOCHIZUKI, NAOKI	
	Examiner Charles D. Adams	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to communications filed on 14 June 2006, claims 8-12 are added per applicant's request. Claims 1-12 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 recites the limitation "the log of data transmitted between the server and the terminal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Akagi (US Patent 6,931,421).

As to claim 1, Akagi teaches:

A local database for storing and managing said examinational information data (see Figure 1 and 4:74-50); and

Comparing means for comparing examinational information data newly read from said server and examinational information data that have already been stored in said local database with each other, and storing the newly read examinational information data into said local database only when the newly read examinational information data have not been stored in said local database (see 5:45-49. The server is element 10 in Figure 1. The local database is contained in element 20, the radiographic apparatus).

As to claim 2, Akagi teaches:

Periodically data reading means for periodically reading said examinational information data from said server (see 5:15-19).

As to claim 3, Akagi teaches:

List displaying means for displaying, on a display unit, a list of examinational information that is produced by merging examinational information data newly read from said server and examinational information data that have already been stored in said local database (see 4:51-53 and Figure 2).

As to claim 4, refer to the rejection of claim 3 above.

As to claim 5, Akagi teaches:

A local database for storing and managing said examinational information data (see 4:74-50); and

Comparing means for comparing examinational information data newly read from said server and examinational information data that have already been stored in said local database with each other, and storing the newly read examinational information data into said local database only when the newly read examinational information data have not been stored (see 5:45-49).

Claim Rejections - 35 USC § 103

6. . The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akagi (US Patent 6,931,421) in view of Tipirneni (US Pre-Grant Publication 2004/0257608).

As to claim 6, Akagi teaches:

A terminal connected to said communication link for receiving and outputting examinational information data that have been stored in said server when the medical imaging apparatus is used (see 4:40-46); and

Akagi does not teach:

A communication monitoring device connected to said communication link for logging communication data transmitted between said terminal and said server,

Wherein said communication monitoring device transmits the examinational information data to said data processing apparatus when said communication monitoring device detects reception by said terminal of said examinational information data from said server.

Tipirneni teaches:

A communication monitoring device connected to said communication link for logging communication data transmitted between said terminal and said server (see paragraph [0038], Figure 10, step 352),

Wherein said communication monitoring device transmits the examinational information data to said data processing apparatus when said communication monitoring device detects reception by said terminal of said examinational information data from said server (see paragraphs [0038]-[0039] and [0041]. The user at the terminal chooses a patient record (examinational information) to examine after receiving a list of patient records. The WEBSTAR service will transmit the chosen examinational information to the GETPATIENT.ACGI for processing).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Akagi by the teaching of Tipirneni, since Tipirneni teaches that "a medical facility may not have the financial resources or patient volume to support a physician on site at all times; the medical facility may be located in a remote location; or a town may not have a sufficient number of physicians available to be located at each medical facility at all times of the day. As such, when a patient requires medical attention, an experienced physician may not be readily available at a particular medical facility. Accordingly, a system is needed which acquires an image of a patient and transmits the image to a remote location for viewing and analysis by an experienced physician (see paragraph [0006]).

As to claim 7, Akagi teaches a system according to claim 5.

A terminal connected to said communication link for receiving and outputting examinational information data that have been stored in said server when the medical imaging apparatus is used (see 4:40-46); and

Akagi does not teach:

A communication monitoring device connected to said communication link for monitoring data communications between said terminal and said server,

Wherein said communication monitoring device sends a command to said server to copy predetermined data included in the examinational information data stored in said server to said local database when data communications between said terminal and said server are detected.

Tipirneni teaches:

A communication monitoring device connected to said communication link for monitoring data communications between said terminal and said server (see paragraph [0038]),

Wherein said communication monitoring device sends a command to said server to copy predetermined data included in the examinational information data stored in said server to said local database when data communications between said terminal and said server are detected (see paragraph [0041]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Akagi by the teaching of Tipirneni, since Tipirneni teaches that "a medical facility may not have the financial resources or patient volume to support a physician on site at all times; the medical facility may be located in a remote location; or a town may not have a sufficient number of physicians available to be located at each medical facility at all times of the day. As such, when a patient requires medical attention, an experienced physician may not be readily available at a particular medical facility. Accordingly, a system is needed which acquires an image of a patient and transmits the image to a remote location for viewing and analysis by an experienced physician (see paragraph [0006]).

As to claim 11, Akagi as modified teaches wherein the communication monitoring device is connected to the server via the communication link (see Akagi 4:35-46 and Figure 1).

As to claim 12, Akagi as modified teaches wherein the log of data transmitted between the server and the terminal becomes transmitted to the comparing means of the data processing apparatus (see Akagi 5:44-49. A log of data transmitted between the server and the terminal (the patient list) is sent to the comparison means), and wherein the data processing apparatus stores the examinational information data into said local database only when the newly read examinational information data from said log have not been previously stored (see Akagi 5:44-49).

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akagi (US Patent 6,931,421) in view of White et al. (US Pre-Grant Publication 2004/0019501).

As to claim 8, Akagi teaches the system of claim 5.

Akagi does not teach wherein the medical imaging apparatus sends an end imaging signal to the server, and when the server receives the end imaging signal, the server deletes examinational information for a corresponding image.

White et al. teaches wherein the medical imaging apparatus sends an end imaging signal to the server, and when the server receives the end imaging signal, the server deletes examinational information for a corresponding image (see paragraphs [0057]-[0059]. The radiologist can return a report to a transcriptionist, in which case it is

deleted from the radiologist's queue. This can be an "end imaging signal", as the radiologist may be done "reviewing the test film" (see paragraph [0057])).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Akagi by the teaching of White et al., since White et al. teaches that "the system is most advantageously applied in the context of a medical testing process that involves a series of steps. The system provides special benefits in a clinical context where the clinic is charged with performing diagnostic testing of a large volume of patients, and the steps in the testing process are performed by multiple staff members" (see paragraph [0029]). In addition to this, it would also have been obvious to remove a patient from the "patient list" queue of Akagi once their scheduled imaging is done.

As to claim 9, Akagi as modified teaches wherein said data processing apparatus further comprises a periodic reading means, which reads examinational information from the server depending on a frequency of forming images performed by the medical imaging apparatus (see 5:15-19 and 5:50-6:2. The period can be set to not update when the frequency of periods when imaging does not occur).

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akagi (US Patent 6,931,421) in view of Banks et al. (US Patent 6,603,494).

As to claim 10, Akagi teaches:

A server for storing and managing examinational information data (see Figure 1, element 10. Also see 4:40-46)

Akagi does not teach for identifying an image obtained by a medical imaging apparatus,

Banks et al. teaches for identifying an image obtained by a medical imaging apparatus (see 15:16-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Akagi by the teaching of Banks et al., since Banks et al. teaches “technologists particularly benefit from the remote services provided. Technologists can control the imaging device remotely, access information remotely, and store information remotely. In this manner, for example, technologists have scheduling tables and information more readily available” (see 24:47-52).

Akagi as modified teaches:

A data processing apparatus (see Akagi element 20 of Figure 1) for merging data of the image obtained by said medical imaging apparatus and the examinational information data from said server into data in a predetermined format (see Banks et al. 15:16-27), said server and said data processing apparatus being connected to each other by a communication link (see Akagi Figure 1),

Said data processing apparatus comprising:

A local database (see Akagi Figure 1 element 21) for storing and managing said examinational information data; and

Comparing means (see Akagi 5:44-49) for comparing examinational information data newly read from said server and examinational information data that have already been stored in said local database with each other, and storing the newly read examinational information data into said local database only when the newly read examinational information data have not been stored (see Akagi 5:44-49).

Response to Arguments

10. Applicant's arguments filed 14 June 2006 have been fully considered but they are not persuasive.

Applicant argues that claim 1 further includes recitations of a server and a data processing apparatus. This argument is incorrect. Akagi teaches a server (see 4:41-46) and a data processing apparatus (see 4:47-50).

Applicant argues "any recitations appearing in the preamble must also be taken into account in making a proper rejection". However, this argument is incorrect. As stated in MPEP 2111.02:

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See *id.* at 808-10, 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble's effect on claim scope, as well as a hypothetical example illustrating these principles.

It should also be noted that many of the items listed in the preamble contain intended use clauses. Limitations of intended use bear no patentable weight. See MPEP § 2106 Section II(C):

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive: >See also MPEP § 2111.04.<

Claims 1, 5-8, 10, and 12 contain subject matter that is optionally recited. The listed claims contain many statements that describe intended use. As these statements are of intended use, the statements in "for" doing something carry no patentable weight. Recitations of a step occurring "when" something else occurs carries no patentable weight, as anything following the "when" may not actually occur.

As to claim 1, the claim recites "a system for storing and managing examinational information data for identifying an image obtained by a medical imaging apparatus" (lines 2-4), "said data processing apparatus for merging data of the image obtained by said medical imaging apparatus and the examinational information data from said server into data in a predetermined format" (lines 4-6), "a local database for storing and managing said examinational information data" (line 8).

As to claim 5, the claim recites "a system for processing examinational information of medical images" (line 1), "a server for storing and managing examinational information data for identifying an image obtained by a medical imaging apparatus" (lines 2-3), "a data processing apparatus for merging data of the image obtained by said medical imaging apparatus and the examinational information data from said server into data in a predetermined format" (lines 3-5), "a local database for storing and managing said examinational information data" (line 8).

As to claim 6, the claim recites "a terminal connected to said communication link for receiving and outputting examinational information data that have been stored in said server when the medical apparatus is used" (lines 2-4), "a communication monitoring device connected to said communication link for logging communication data transmitted between said terminal and said server" (lines 5-6), "when said communication monitoring device detects reception by said terminal of said examinational information from said server" (lines 8-9)

As to claim 7, the claim recites "a terminal connected to said communication link for receiving and outputting examinational information data that have been stored in said server when the medical apparatus is used" (lines 2-4), "a communication monitoring device connected to said communication link for mentoring data communications between said terminal and said server" (lines 5-6), "when data communications between said terminal and said server are detected" (see line 9)

As to claim 8, the claim recites “when the server receives the end imaging signal” (line 2).

As to claim 10, the claim recites “a server for storing...” (lines 3-4), “a data processing apparatus for merging data...” (lines 5-7), “a local database for storing...” (line 10).

As to claim 12, the claim recites “and wherein the data processing apparatus stores the examinational information data into said local database only when the newly read examinational information data from said log have not been previously stored” (lines 3-5).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “Akagi does not specifically teach aspects of the claim, such as merging of the medical image and the examinational data into a predetermined format) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argues that the WEBSTAR does not log the data transmitted between the server and the terminal. This argument is incorrect. As noted in paragraph [0038], a physician logs onto a host server. The WEB STAR program logs the physician's Internet Protocol address. As this address is sent by the physician to the host server, it is "communication data transmitted between said terminal and said server".

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2164


SAM RIMELL
PRIMARY EXAMINER